

## REMARKS

### Specification

The Examiner has objected to the specification. Specifically, the Examiner has objected to the disclosure as being "indefinite because the examiner does not know what 'EPDM' stands for." In response, Applicant has amended the Specification to recite "synthetic rubber." No new matter has been added. *See Application, page 2, line 29.* The Applicant respectfully submits that the foregoing amendment to the specification obviates the Examiner's objection.

### Claim Rejections

#### **Rejections under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected Claim 4 pursuant to 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner alleges that "second jaw" should be changed to "first jaw" for clarification. In response, Applicant has amended Claim 4 to recite "first jaw." No new matter has been added. *See Application, page 3, lines 24-25.* Applicant respectfully submits that the foregoing amendment to Claim 4 obviates the Examiner's objection.

#### **Rejections under 35 U.S.C. § 102(b)**

The Examiner has rejected Claims 1, 4-5, and 10 pursuant to 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,669,668 to Itoh et al. ("Itoh et al."). The Examiner specifically alleges that Itoh et al. disclose a first 4 and a second jaw 5, the second jaw 5 unitarily formed with the first jaw. According to the Examiner, the outward facing surface of the second jaw comprises at least one notch 21 and the first jaw comprises a tension strap having at least one through-aperture 26 releasably engaged with at least one notch of the second jaw, the tension strap extending from the inward facing surface of the first jaw. Further, according to the

Examiner, the second ends of the first and second jaws further comprise means (12) to mount the clamp on a surface.

To anticipate a claim pursuant to 35 U.S.C. § 102, the "reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *See PPG Industries v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996) (emphasis added). *See also Motorola v. Interdigital Technology Corp.*, 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997). Because Itoh et al. neither disclose each and every element of the one-piece molded clamp claimed in Claims 1, 4-5, and 10, nor enable one skilled in the art to make the claimed one-piece clamp, Itoh et al. simply do not anticipate the present invention.

Applicant respectfully traverses the rejection because, among other deficiencies of Itoh et al., Itoh et al. do not disclose a clamp having a first and a second jaw, wherein said jaws are unitary with one another. Furthermore, Itoh et al. do not disclose a tension strap unitarily formed with said first jaw wherein said tension strap has at least one through-aperture through which said second jaw is able to pass, and wherein said tension strap is able to be releasably engaged with notches formed in the other jaw.

Claim 1 of Applicant's invention claims a one-piece molded clamp that possesses a novel one-piece design wherein all components of the clamp are unitary with one another. A tension strap with at least one through-aperture extends from one of the jaws and is able to be releasably engaged with notches that are formed in the other jaw upon the other jaw being passed through the aperture.

Itoh et al. do not disclose the dual-jaw design of Applicant's invention. Respectfully, the Examiner mistakenly identifies Itoh et al. as disclosing a first 4 and a second 5 jaw. Rather the Applicant respectfully submits that Itoh et al. has two plate-shaped protrusions 4 and 5 projectingly provided on both ends of the base 1. *See* Itoh et al., Column 3, lines 1-3. Instead of a first and a second jaw, as in Applicant's claimed invention, Itoh et al. has a single flat clamp 7 that is rockingly connected to an upper end of the plate-shaped protrusion 4 through a thin connecting portion 6. *See* Itoh et al., Column 3, lines 3-5; Column 4, lines 31-33. The plate-shaped protrusions 4 and 5 are not even part of single flat clamp 7. Rather, flat clamp 7 is connected to plate shaped protrusion 4 and is fixed onto plate-shaped protrusion 5 by the locking portions 8. *See* Column 3, lines 3-4; Column 4, lines 5-6. Thus, Itoh et al. cannot anticipate Applicant's claimed invention because Itoh et al. do not disclose a first jaw and a second jaw unitarily formed with the first jaw as claimed in Claim 1 of the present invention.

Second, with respect to the Examiner's allegation that Itoh et al. have a first jaw that comprises "a tension strap 7 having at least one through-aperture through 26 releasably engaged with at least one notch of the second jaw," Applicant respectfully submits that Itoh et al. do not disclose a tension strap having at least one through-aperture. Therefore, not only do Itoh et al. fail to disclose a first and a second jaw unitary with one another, Itoh et al. also fail to disclose a tension strap unitarily formed with the first jaw, let alone a tension strap having a through-aperture through which the second jaw is able to pass.

Finally, with respect to the Examiner's allegation that Itoh et al. disclose at least one notch on the outward facing surface of the second jaw, Applicant respectfully submits that Itoh et al. do not disclose a second jaw, and therefore cannot disclose at least one notch on the second

jaw. Therefore, Applicant respectfully submits that Itoh et al. fail to disclose a unitary first and second jaw, a tension strap unitarily formed with the first jaw, a tension strap having a through aperture, and a notch on the outward facing surface of the second jaw, as claimed in Applicant's Claim 1.

Accordingly, Itoh et al. do not anticipate the claimed invention. Further, none of the prior art of record discloses a first and a second jaw unitary with one another wherein there is a tension strap unitarily formed with said first jaw, where said strap has at least one through-aperture through which said second jaw is able to pass, and wherein said tension strap is able to be releasably engaged with notches formed in the other jaw, as claimed in Applicant's Claim 1.

**Rejections under 35 U.S.C. § 103(a)**

The Examiner has rejected Claims 2-3 pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over Itoh et al. in view of U.S. Patent No. 6,164,604 to Cirino et al. ("Cirino et al.").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all of the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143.03. Therefore, it is improper for the Examiner to use the applicant's invention as a blueprint to hunt through the prior art for the claimed elements

and then combine them as claimed. *See In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). Finally, and of particular importance here, the reference or combination of references must teach or disclose *all of the claimed limitations of the invention*. *See Id.*

The Examiner alleges that "[i]t would have been obvious for one of ordinary skill in the art at the time the invention was made to have added protrusion to Itoh et al.'s inward facing surfaces as taught by Cirino et al." Applicant respectfully traverses Examiner's rejection because neither Itoh et al. alone nor in combination with Cirino et al., teach or motivate a skilled artisan to arrive at the claimed clamp having a unitary first and a second jaw and having at least one tension strap that extends from one of the jaws and having a through-aperture that releasably engages with notches formed in the other jaw upon the other jaw passing through the through-aperture. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As discussed above, Itoh et al. do not disclose a unitary first and second jaw, with a tension strap having at least one aperture, said strap extending from one of the jaws and releasably engaging with notches formed in the other jaw upon the other jaw passing through the aperture, as claimed in Claim 1. Furthermore, there is nothing in Itoh et al. to teach the skilled artisan to modify Itoh et al. to have the elements of Applicant's Claim 1, particularly unitary jaws and a tension strap having a through-aperture. Therefore, Itoh et al. does not teach or suggest all of the elements of Applicant's claimed invention. *See In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

Additionally, Cirino et al. do not disclose a unitary first and second jaw, wherein a tension strap is unitarily formed with the first jaw, the tension strap having at least one through-aperture through which the second jaw is able to pass. Further, Cirino et al. fails to disclose at

least one notch on the second jaw, the tension strap able to be releasably engaged with at least one notch formed in the other jaw.

Since Itoh et al. fail to teach all of Applicant's claimed elements, Cirino et al.'s teaching with respect to a plurality of projections on the arcuate inner walls becomes moot. Therefore, because Itoh et al. do not teach the elements of Applicant's Independent Claim 1, the addition of Cirino et al. cannot ameliorate the deficiencies of Itoh et al. Therefore, the rejection cannot stand and withdrawal thereof is respectfully requested.

The Examiner has rejected Claim 6 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Itoh et al. in view of U.S. Patent No. 4,766,651 to Kobayashi et al. ("Kobayashi et al.") on the grounds that it would have been obvious to clamp Itoh et al.'s device on the surface of a vehicle as taught by Kobayashi et al. Applicant respectfully traverses Examiner's rejection because Itoh et al. do not teach, suggest, or motivate the claimed invention in view of Kobayashi et al..

As discussed above, Itoh et al. do not teach or suggest all of the elements of Applicant's claimed invention. Likewise, Kobayashi et al. do not teach or suggest a unitary first and second jaw, wherein a tension strap is unitarily formed with the first jaw, the tension strap having at least one through-aperture through which the second jaw is able to pass. Further, Kobayashi et al. fail to disclose at least one notch on the second jaw, the tension strap able to be releasably engaged with at least one notch.

The addition of Kobayashi et al. to Itoh et al. does not yield the claimed invention because Kobayashi et al. disclose a fixing clip 11 attached to the lower side of planar body 10 for securing body 10 to a panel such as an automobile body. Therefore, because Itoh et al. do not

teach the elements of Applicant's Independent Claim 1, the addition of Kobayashi et al. cannot ameliorate the deficiencies of Itoh et al. Therefore, the rejection cannot stand and withdrawal thereof is respectfully requested.

The Examiner has rejected Claim 7 as being unpatentable over Itoh in view of U.S. Patent No. 5,930,872 to McBride et al. ("McBride et al.") because it would have been obvious for a skilled artisan to have modified Itoh et al.'s clamp material to a polymer as taught by McBride et al. Applicant respectfully traverses the rejection.

As discussed above, the primary reference, Itoh et al., does not teach or suggest all of the elements of Applicant's claimed invention. Further, there is no suggestion in Itoh et al. to modify the clamp of Itoh et al. to arrive at the claimed invention with any reasonable expectation of success. Therefore, any alleged teaching in McBride et al. regarding the use of polymer material does not ameliorate the deficiencies of the Itoh et al. reference.

The Examiner has rejected Claim 8 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Itoh et al. in view of U.S. Patent No. 6,496,094 to May III ("May III") because it would have been obvious to modify Itoh et al.'s clamp material to rubber as taught by May III. Applicant respectfully traverses Examiner's rejection because Itoh et al., and Itoh et al. in view of May III, fail to teach or suggest each and every element of Applicant's claimed invention.

As discussed above, Itoh et al. do not teach or suggest each and every element of Applicant's claimed invention. Further, there is no teaching or suggestion in Itoh et al. to modify the clamp of Itoh et al. to arrive at the claimed invention with any reasonable expectation of success. Therefore, any alleged teaching in May III regarding the use of rubber does not ameliorate the deficiencies of the Itoh et al. reference.

*Serial No. 10/608,735  
Amdt. dated September 27, 2004  
Reply to Office Action of July 1, 2004*

The Examiner has rejected Claim 9 as being unpatentable over Itoh et al. in view of U.S. Patent No. 3,827,093 to Davis ("Davis") because it would have been obvious to have modified Itoh et al.'s clamp material to synthetic rubber as taught by Davis. Applicant respectfully traverses the rejection.

As discussed above, the primary reference, Itoh et al., does not teach or suggest all of the elements of Applicant's claimed invention. Further, there is no teaching or suggestion in Itoh et al. to modify the clamp of Itoh et al. to arrive at the claimed invention with any reasonable expectation of success. Therefore, any alleged teaching in Davis regarding the use of synthetic rubber does not ameliorate the deficiencies of the Itoh et al. reference.

Finally, none of the prior art of record discloses a first and a second jaw unitary with one another wherein there is a tension strap unitarily formed with said first jaw, where said strap has at least one through-aperture through which said second jaw is able to pass, and wherein said tension strap is able to be releasably engaged with notches formed in the other jaw, as claimed in Applicant's Claim 1.

Respectfully submitted,

By

  
\_\_\_\_\_  
Alicia M. Passerin  
PTO Registration No. 54,363  
Cohen & Grigsby, P.C.  
11 Stanwix Street, 15th Floor  
Pittsburgh, PA 15222  
(412) 297-4900

897932\_1